

### **Remarks/Arguments**

Claims 1-2, 4-5, 7-13, 15-18, 20-21, and 23-24 are pending in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

### **Claim Rejections Under 35 USC § 102**

Claims 1-2, 5, 7-13, 16-18, 20-21, and 23-24 stand rejected under 35 U.S.C. § 102(e) or (b) as being anticipated by Klein, et al. (U.S. Pat. No. 6,673, 541 and WO 00/17390).

Applicant respectfully submits that Klein fails to disclose or teach at least the following as set forth by claims 1, 7, 9, 11, 13, 16-18, 20, and 23: methods of detecting one or more DNA markers in cell-free bone marrow samples. The specification defines a cell-free bone sample, for example, at p. 24, ll. 25-29; p. 25, ll. 21-22; and p. 61, ll. 8-9. Cell-free bone samples refer to the supernatant plasma that is separated from bone marrow. In contrast, Klein discloses the amplification of a single bone marrow cell for changes in the chromosome using CGH analysis (col. 2, , ll. 50-54; col. 5, ll. 9-12; col. 17, ll. 1-13). Klein's invention is drawn to the reliable and uniform amplification of small amounts of DNA from a single cell (col. 10, ll. 51-54) and not to the detection of DNA markers from cell-free bone marrow samples. As such, Klein does not teach or suggest the methods of the present claims.

Accordingly, Klein does not anticipate present claims 1, 7, 9, 11, 13, 16-18, 20, and 23. Likewise, dependent claims 2, 4-5, 8, 10, 12, 21, and 24 are also patentable over Klein for at least the same reasons as claim 1, 7, 9, 11, 13, 16-18, 20, and 23. In view of the foregoing, Applicant respectfully requests that the Office withdraw the rejection.

Appl. No. 10/809,965  
Amdt. Dated : November 9, 2009  
Reply to Office Action of May 8, 2009

Attorney Docket No. 89212.0016  
Customer No.: 26021

### **Claim Rejections Under 35 USC § 103**

Claims 4 and 15 are rejected under 35 USC § 103(a) as being unpatentable over Klein in view of Silva et al. ((2002) Ann. Surg. Oncol. 9(1):71-76). Applicants respectfully traverse.

Claim 4 depends from claim 1, and as such includes all the limitations thereof, and is therefore patentable over Klein for at least the same reasons discussed above with regard to claim 1. Likewise, claim 15 is patentable over Klein for at least the same reasons discussed above.

Silva is not seen to remedy the defects of Klein and is cited for its relevance regarding DNA markers. Further, Silva suggest that undetected micrometasis may be detected in patients if they exhibit DNA with characteristics of tumor DNA after having a mastectomy. Silva does not teach that detection of mutations in one or more markers is indicative of cancer, poor prognosis, or a mutation in a gene. As such, the combined teachings of the prior art fail to teach or suggest each element of the claimed invention. Thus, the combination suggested by the Office cannot render the claimed invention obvious.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned at the Los Angeles, California telephone number (310) 785-4617 to discuss the steps necessary for placing the application in condition for allowance.

Appl. No. 10/809,965  
Amdt. Dated : November 9, 2009  
Reply to Office Action of May 8, 2009

Attorney Docket No. 89212.0016  
Customer No.: 26021

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,  
HOGAN & HARTSON L.L.P.

Date: November 9, 2009

By: 

Natalie A. Davis  
Registration No. 53,849  
For Applicants

1999 Avenue of the Stars, Suite 1400  
Los Angeles, California 90067  
Phone: 310-785-4600  
Fax: 310-785-4601